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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,177

03/19/2004

Robert Tonkin

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10/16/2006

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

COLAN, GIOVANNA B

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/804,177	TONKIN, ROBERT	
	Examiner	Art Unit	
	Giovanna Colan	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/1/05, 9/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant filed application on 03/19/2004.
2. Claim 1 is pending.
3. The information disclosure statement (IDS) submitted on 06/01/2005, and 09/29/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garrido (US Patent No. 6,012,890, filed October 1997) in view of E-Muni Electronic Bound Volumes, pages downloaded from <<http://www.emuni.com/boundvol.html>> on 3/19/2002, last updated 4/18/1997, pp. 1-7 (E-Muni hereinafter).

Regarding Claim 1, Garrido discloses a method of obtaining and processing information for creating a document, said method comprising:

(a) transmitting a data packet to a remote terminal (Col. 3, lines 4 – 10, Garrido), said data packet and to enable a user to input document information specifies an arrangement of components for creating a document (Col. 3, lines 21 – 25, "book's

contents and allow the reformatting of the size and type of fonts to accommodate the needs ... ", Garrido), the components including at least two of: a printed page, a tab page, a front cover, a back cover, and a binding (Col. 5, lines 50 – 54, Garrido):

(b) evaluating the document information by utilizing stored properties for the components to determine whether it is physically possible to create a document according to the document information (Col. 7, lines 36 – 43, Garrido¹); and

(c) receiving the document information from the remote terminal (Col. 5, lines 51 – 54, " receive electronic data sent by the CDU 1", Garrido).

Garrido discloses all the limitations as discussed above including user interaction means (Col. 5, lines 66 – 67, Garrido). However, Garrido is silent with respect to a user interface. On the other hand, E-Muni discloses information to generate a user interface (Page 1 and 6, E-Muni). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the E-Muni's teachings to the system Garrido. Skilled artisan would have been motivated to do so, as suggested by E-Muni (Page 2 and 5, E-Muni), to provide users with online access via internet, to immediately delivery documents to the screen by clicking, and to save time by providing fully searchable indices. In addition, both of the references (Garrido and E-Muni) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, electronic documents, and user interaction. This close relation between both of the references highly suggests an expectation of success.

Prior Art Made Of Record

1. Garrido (US Patent No. 6,012,890, filed October 1997) discloses an electronic bookstore vending machine.
2. E-Muni Electronic Bound Volumes, pages downloaded from
<<http://www.emuni.com/boundvol.html>> on 3/19/2002, last updated 4/18/1997, pp. 1-7
3. Suzuki et al. (US Patent No. 5,923,013) discloses a print control system and method for controlling the system in page by page basis.

¹ Wherein the step of accommodating a variety of paper sizes and enhancing the **acceptance** corresponds to the step of evaluating the document information as claimed; and wherein the variety of paper sizes corresponds to the stored properties as claimed.


Points Of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
September 11, 2006


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100